



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,005	12/14/2001	Tommy Petrogiannis	9680.189USU1	2783

7590 03/25/2005
MERCHANT & GOULD, P.C.
3200 IDS Center
80 South Eighth Street
Minneapolis, MN 55402-2215

EXAMINER

COULTER, KENNETH R

ART UNIT	PAPER NUMBER
----------	--------------

2141

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,005

Applicant(s)

PETROGIANNIS ET AL.

Examiner

Kenneth R Coulter

Art Unit

2141

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/1/02.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities:

Figure 2B is not detailed in the BRIEF DESCRIPTION OF THE DRAWINGS section (p. 5, line 29 of the specification).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 – 60 are rejected under 35 U.S.C. 102(e) as being anticipated by Borrowman et al. (U.S. Pat. Pub. No. 2004/0039912) (Computer Networked System and Method of Digital File Management and Authentication).

2.1 Regarding claim 1, Borrowman discloses a method for a proponent to enable the secure approval of an electronic document by a correspondent over a network, said method comprising the steps of:

Art Unit: 2141

a) providing a server application on a proponent server connected to the network, said server application comprising approval tools for the secure approval of the electronic document (Abstract "a processing service that may be **located remotely** on a computer network that receives digital files from the users and performs file identification, **authentication** and verification, including time, **digital signature**, ..."; Fig. 9, item 906; p. 7, paragraph 93 "Authentidate server 906"; "Authentidate may then run the digital signature program on the recently submitted digital copy of the document ...");

b) providing a correspondent application on a correspondent terminal connected to the network, said correspondent application allowing the correspondent to remotely and securely access the approval tools on the proponent server through the network from the correspondent terminal (Abstract; Fig. 9; p. 7, paragraph 93);

c) making the electronic document available on the correspondent terminal (Abstract; Fig. 9; p. 7, paragraph 93); and

d) approving the electronic document on the correspondent terminal using said approval tools accessed by the correspondent application (Abstract; Fig. 9; p. 7, paragraph 93).

2.2 Per claim 2, Borrowman teaches the method according to claim 1, wherein step d) comprises a sub-step of verifying an electronic signature provided on the electronic document made available in step c) (Abstract "a processing service that may be located remotely on a computer network that receives digital files from the users and performs

Art Unit: 2141

file identification, **authentication** and verification, including time, **digital signature**, ...”).

2.3 Regarding claim 3, Borrowman discloses the method according to claim 1, wherein step d) comprises applying a correspondent electronic signature on the electronic document (Fig. 9; p. 7, paragraph 93).

2.4 Per claim 4, Borrowman teaches the method according to claim 1, comprising an additional step of: e) securely printing the electronic document as approved in step d) from the correspondent terminal (p. 5, paragraph 65).

2.5 Regarding claim 5, Borrowman discloses the method according to claim 1, comprising an additional step, before step c) of providing a proponent application on a proponent terminal connected to the network, said proponent application allowing the proponent to remotely and securely access the approval tools on the proponent server through the network from the proponent terminal (Fig. 9).

2.6 Per claim 6, Borrowman teaches the method according to claim 5, wherein step c) comprises electronically transmitting the electronic document from the proponent terminal to the correspondent terminal (Fig. 9; p. 6, paragraph 79).

2.7 Regarding claim 7, Borrowman discloses the method according to claim 6, wherein, in step c), a messaging application is used for electronically transmitting said

Art Unit: 2141

electronic document (Fig. 9; p. 6, paragraph 79).

2.8 Per claim 8, Borrowman teaches the method according to claim 5, comprising an additional step of: e) transmitting the electronic document as approved in step d) from the correspondent terminal to the proponent terminal (Fig. 9; p. 7 paragraph 92, 93).

2.9 Regarding claim 9, Borrowman discloses the method according to claim 8, comprising an additional step of: f) securely printing the electronic document as approved in step d) from the proponent terminal (p. 5, paragraph 65).

2.10 Per claim 10, Borrowman teaches the method according to claim 1, wherein the server application of step a) further comprises enrolment tools for enrolling the correspondent, and step b) comprises enrolling said correspondent using said enrolment tools (Fig. 9; p. 7 paragraph 92, 93).

2.11 Regarding claim 11, Borrowman discloses the method according to claim 10, wherein step b) comprises the sub-steps of: (i) transmitting a user ID and password to the correspondent terminal; (ii) accessing the proponent server from the correspondent terminal using said user ID and password; (iii) downloading the correspondent application from the proponent server to the correspondent terminal; (iv) installing said correspondent application on said correspondent terminal (Fig. 9; p. 7 paragraph 92, 93).

2.12 Per claim 12, Borrowman teaches the method according to claim 11, wherein step b) comprises an additional sub-step of: (v) generating a correspondent electronic signature representative of said correspondent (Fig. 9; p. 7 paragraph 92, 93).

2.13 Regarding claim 13, Borrowman discloses the method according to claim 12, wherein step b) comprises an additional sub-step of: (vi) generating a correspondent identifier on the proponent server, the correspondent electronic signature being stored therein (Fig. 9; Abstract; p. 7 paragraph 92, 93).

2.14 Per claims 14 – 60, the rejection of claims 1 – 13 under 35 USC 102(e) (paragraphs 2.1 – 2.13) applies fully.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on 5 4 9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2141

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

krc

KENNETH R. COULTER
PRIMARY EXAMINER
